

REMARKS/ARGUMENTS

The claims are not amended in this paper.

Related Art Rejections

1. The rejection of claims 1-4, 6, 9, 10, 19 and 20 under 35 USC § 103(a) in view of US 2003/0153472 ("*Nagano*") and US 5,198,129 ("*Hata*") is respectfully traversed.

There is no motivation to combine the references. The base oil in *Nagano* is "an ester of a dicarboxylic acid containing 10 carbon atoms" ([0032] of *Nagano*). Further, "[a]n alcohol to be used for the formation of an ester with the aforementioned dicarboxylic acid containing 10 carbon atoms is a **monovalent aliphatic alcohol containing 6-10 carbon atoms**" ([0033] of *Nagano*, emphasis added). *Nagano* says of such esters:

An ester of a dicarboxylic acid containing 11 or more carbon atoms produces a higher torque in rotation and does not give a required performance. On the other hand, with the use of an ester of a dicarboxylic acid containing 9 or less carbon atoms, the amount of evaporation increases rapidly and it is not possible to realize a long life for spindle motors.

([0032] of *Nagano*).

Hata, on the other hand, requires "blending unsaturated aliphatic alcohols of from 16 to 24 carbon atoms...into lubricating base oils" (column 1, lines 51-52). Thus, combining *Nagano* and *Hata* would mean adding the unsaturated aliphatic alcohols having 16 to 24 carbon atoms of *Hata* to the dicarboxylic acids of *Nagano* to produce esters of a dicarboxylic acid that would **not** contain 10 carbon atoms.

Accordingly, one of ordinary skill in the art would not have considered modifying *Nagano* in view of *Hata*, because *Hata* discloses alcohols that would produce a base oil for *Nagano* that would be insufficient for the *Nagano* invention.

Withdrawal of the rejection is respectfully requested.

The presently claimed lubricating oils are particularly effective in degreasing efficiency, where the measurement thereof is described in the present specification:

(b) Degreasing test

A sintered metal impregnated with the oil was subjected to extraction with n-hexane. The residual amount of the oil in the sintered metal after the extraction was measured.

See page 11, [0035] of the specification as filed. The acid phosphite esters of the present claims are particularly effective in this regard, which can be seen by comparing Example 3 (an oil having dioleoyl hydrogen phosphite) and Example 6 (an oil having tri(2-ethylhexyl)phosphate). In Example 3, the residual amount of oil was found to be 0.0012 in the degreasing test; on the other hand, the same was found to be 0.0125 for Example 6. See claims 19-21.

There is no discussion of degreasing efficiency in both of *Nagano* and *Hata*. Moreover, *Hata* discloses that zinc dithiophosphates must be present: these compounds are known to have adsorptive properties, which would result in poor degreasing efficiency. *Hata* also only exemplifies a phosphate (Example 12) that is not an acid phosphite ester.

Withdrawal of the rejection is respectfully requested.

2. The rejection of claims 11-17 under 35 USC § 103(a) in view of *Nagano*, *Hata*, and US 2002/0114980 ("*Gunsel*") is respectfully traversed for the same reasons given above—*Gunsel* does not remedy the problem of combining *Hata* and *Nagano*, discussed above.

Accordingly, the rejection is no longer tenable and should be withdrawn.

3. The rejection of claims 15-17 under 35 USC § 103(a) in view of *Nagano*, *Hata*, and US 5,275,630 ("*Dorer*") and US 5,484,542 ("*Cahoon*") is respectfully traversed for the same

reasons given above—neither of *Dorer* and *Cahoon* remedy the problem of combining *Hata* and *Nagano*, discussed above.

Accordingly, the rejection is no longer tenable and should be withdrawn.

4. The rejection of claim 18 under 35 USC § 103(a) in view of *Nagano*, *Hata*, and US 6,586,376 ("*Nakanishi*") is respectfully traversed for the same reasons given above—*Nakanishi* does not remedy the problem of combining *Hata* and *Nagano*, discussed above.

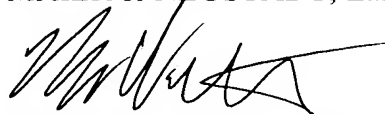
Accordingly, the rejection is no longer tenable and should be withdrawn.

Conclusion

Applicant respectfully submits that the above-identified application is in condition for allowance. Notification thereof is requested.

Respectfully submitted,

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